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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,013	11/20/2000	Keunsuk P. Chang	361752000500	7915

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EXAMINER	
NGUYEN, KIMBERLY T	
ART UNIT	**PAPER NUMBER**
1774	13

DATE MAILED: 11/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-13

Office Action Summary	Application No.	Applicant(s)	
	09/715,013	CHANG ET AL.	
	Examiner	Art Unit	
	Kimberly T. Nguyen	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 August 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20 and 23-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20 and 23-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

This action is in response to the amendment submitted on August 27, 2002. Acknowledgement is made of the Declaration by Keunsuk P. Chang submitted on August 27, 2002.

Objection of Specification

The amendment filed August 27, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendment of the specification wherein the phrase "air, CO_2" was deleted from pages 3, 5, and 7 constitutes new matter since Applicants had originally included air and CO_2 as gases in which the discharge treatment of the polyolefin resin layer was preferably conducted in.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Claims 1-8, 10-16, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya et al., U.S. Pat. No. 5,137,955 as previously stated in the Office Action submitted on July 17, 2002.

Claims 9, 17-18, 33, and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya et al., U.S. Pat. No. 5,137,955 in view of Kurokawa et al., U.S. Pat. No. 5,698,317 as previously stated in the Office Action submitted on July 17, 2002.

Claims 19-20 and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya et al., U.S. Pat. No. 5,137,955 in view of Tanizaki et al., U.S. Pat. No. 5,998,039 as previously stated in the Office Action submitted on July 17, 2002.

Claims 24 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya et al., U.S. Pat. No. 5,137,955 in view of Yokoyama et al., U.S. Pat. No. 5,939,205 in further view of Akao et al., U.S. Pat. No. 5,492,741 as previously stated in the Office Action submitted on July 17, 2002.

Claims 25-32, 34-40, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya et al., U.S. Pat. No. 5,137,955 in view of Yokoyama et al., U.S. Pat. No. 5,939,205 as previously stated in the Office Action submitted on July 17, 2002.

Response to Arguments

Applicants' argument filed August 27, 2002 have been fully considered but they are not persuasive.

On pages 4 and 5-6, Applicants argue that the making of the instant invention requires the treatment in either a N_2 atmosphere or in an atmosphere of a mixture of N_2 and CO_2. Applicants also supports this argument with the Declaration of Chang submitted on August 27, 2002 which explains that corona discharge treatment under CO_2 or in air does *not* produce the claimed nitrogen functional group-containing surface. Examiner is not persuaded. Mr. Chang's Declaration is not persuasive because Applicants have not shown that the laminate film must be

not shown!

treated in a vacuum atmosphere comprising only N_2 or only a mixture of N_2 and CO_2. Further, air comprises a mixture of N_2 and CO_2 and thus, such nitrogen functional groups on the surface layer would be present in the invention of Tsuchiya since Tsuchiya shows that the corona discharge treatment is carried out in air (column 6, lines 3-6). In addition, Applicants do not specifically limit the gases in which the discharge treatment is performed; Applicants show in claim 23 that "said discharge-treated surface is formed in an atmosphere of CO_2 and N_2" and, in light of the specification, *air* could be used as such a source of the CO_2 and N_2 to perform the discharge treatment. Applicants' amendment to delete the term "air" from the specification introduces new matter.

Further, Applicants' assertion that the laminate film must be discharge-treated in either a N_2 atmosphere or in an atmosphere of a mixture of N_2 and CO_2 is a process limitation. In claim 23, the phrase "said discharge-treated surface is formed in an atmosphere of CO_2 and N_2" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113.* Further, process limitations are given no patentable weight in product claims.

On page 4, Applicants argue that the Examiner did not make the previous rejection a proper Final rejection since nothing in the previous Action indicated that the merits of Mr. Chang's Declaration was considered. Examiner is not persuaded because Mr. Chang's Declaration explained the differences between the instant invention and the film of *Kurokawa,* U.S. Pat. No. 5,698,317. In the Action submitted on July 17, 2002, the previous rejection using

Kurokawa was withdrawn. Thus, Mr. Chang's Declaration concerning Kurokawa was moot and the Action was properly final.

On page 5, Applicants argue that Mr. Chang's Declaration of May 6, 2002 shows that the barrier durability properties of the instant invention are unexpected and thus, claims 25-46 are patentable. Examiner is not persuaded because Applicants have not shown that Tsuchiya does not possess the same barrier durability properties. Further, Tsuchiya comprises the same or similar components of the laminate film. Absent any evidence to the contrary, it would be known that the film of Tsuchiya, in view of the other cited references, would possess the same barrier durability.

On pages 6-7, Applicants argue that there is no evidence in Tsuchiya that the nitrogen functional group content is a result-effective variable or that it would have been obvious to optimize the nitrogen functional group content because it was not evidenced that persons of ordinary skill in the art would have considered the nitrogen functional group content to be a desirable feature to be attained. Examiner is not persuaded. Tsuchiya shows that the discharge treatment occurs in an atmosphere of air, i.e. CO_2 and N_2. The laminate of Tsuchiya thus contains the nitrogen functional groups on the surface of the laminate. Further, Tsuchiya shows that such a treatment in air advantageously improves the laminate's adhesion to printing or vacuum deposition and controls the adhesiveness, slip, and anti-blocking levels of the film.

In addition, Applicants' argument on page 7 that there is no evidence in Tsuchiya to motivate the skilled artisan to use corona discharge treatment on the surface of a polyolefin layer to induce a nitrogen functional group content is not persuasive. A recitation of the intended use to induce the nitrogen functional group content by discharge treatment of the claimed invention

must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. It does not matter what the intended use is in an article claim. Tsuchiya shows Applicants' invention without any structural differences. Thus, such a treatment of the invention of Tsuchiya would be capable of "inducing the nitrogen functional group content," which is the intended use of Applicants' invention. The prior art structure of Tsuchiya thus meets the claims of Applicant's disclosure.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the

organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Kimberly T. Nguyen
Examiner
November 15, 2002

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700